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10/524,264

02/11/2005

Marco Daher

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EXAMINER

WIECZOREK, MICHAEL P

ART UNIT

PAPER NUMBER

4172

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DELIVERY MODE

04/15/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/524,264 | DAHER ET AL. | |
| | Examiner | Art Unit | |
| | Michael Wieczorek | 4172 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 2, 15, 18 and 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-14, 16 and 17 is/are rejected.
- 7) ☒ Claim(s) 1 and 12 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 February 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election of Species

1. During a telephone conversation with Harvey Jacobson on April 2, 2008 a provisional election was made with traverse to prosecute the invention of Group I, claims 1, 3-14, 16-17 and the species of claim 3. Affirmation of this election must be made by applicant in replying to this Office action. Claims 2, 15, 18-19 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Election/Restrictions

2. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-17, drawn to an apparatus for forming glue profiles.

Group II, claim(s) 18-19, drawn to a method for forming glue profiles.

Lack of Unity

3. Lack of unity of invention may be may only become apparent “a posteriori,” that is, after taking the prior art into consideration, in the case of independent claims to A + X and A + Y, unity of invention(i.e. species) is present a posteriori as A is common to both claims.

The inventions listed as Groups I-II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the special technical feature which is referred to Annex B of Appendix A1 of the MPEP (Administrative Instructions under the PCT, "Unity of Invention"). The express "special technical features" is defined as meaning those technical features that define a contribution which each of the inventions, considered as a whole, makes over the prior art." (Rule 13.2). Unity exists only when there is a technical relationship among the claimed inventions involving one or more of the same or corresponding claimed special technical features. In this case, the technical feature shared by each invention is the apparatus for forming glue profiles.

The question of unity of invention has been reconsidered retroactively by the examiner in view of the search performed; a review of U.S. Patent # 5,876,502 (Sugimura et al), makes clear that the inventions of the groups I-II lack the same or corresponding special technical feature because the cited reference(s) appear to demonstrate that the claimed technical feature does not define a contribution which each of the inventions, considered as a whole, makes over the prior art. Accordingly, the prior art of the record supports restriction of the claimed subject matter in to the groups as mentioned immediately above.

4. This application contains claims directed to the following patentably distinct species: a pressure reservoir comprising a compressible medium (claim 2) and a pressure reservoir comprising a third reservoir (claim 3). The species are independent or distinct because claims to the different species recite the mutually exclusive characteristics of such species. In addition, these species are not obvious variants of each other based on the current record.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 10-13, 17 are generic.

There is an examination and search burden for these patentably distinct species due to their mutually exclusive characteristics. The species require a different field of search (e.g., searching different classes/subclasses or electronic resources, or employing different search queries); and/or the prior art applicable to one species would not likely be applicable to another species; and/or the species are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species to be examined even though the requirement may be traversed (37 CFR 1.143) **and (ii) identification of the claims encompassing the elected species**, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

The election of the species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the election of species requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected species.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the species unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other species.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141.

Drawings

5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “valves (43)” of claim 12 must be shown or the feature canceled from the claim. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an

application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

6. The drawings are objected to because the number "45" appears in Figure 6 but it does not reference any component shown in Figure 6. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

7. Claim 1 is objected to because of the following informalities: the invention of claim 1 is referred to as both an “apparatus” and a “device”; and “[sic]” appears within the preamble of the claim. Appropriate correction is required.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Lack of Written description

9. Claims 8-9, 12-13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 8 specifies that the third glue reservoir “also communicates with a pressure reservoir”. There is no description within the written description specifying that one of the embodiments of the invention is that the third glue reservoir “communicates” with a pressure reservoir or how the third reservoir is pressurized to a higher pressure than the second glue reservoir.

Claim 9 specifies that the third glue reservoir comprises several glue pressure levels connected in series. There is no description within the written description specifying that one of

the embodiments of the invention is that the third glue reservoir comprises several pressure levels connected in series. The written description does specify that one of the invention embodiments is for the third glue reservoir to comprise a pair of subreservoirs as depicted in Figure 7 of the present case. But the subreservoirs of Figure 7 are shown to be connected in parallel, not in series.

Claims 12-13 specify that the apparatus further comprises a "glue discharge system (114)", which "allows the discharge of glue by the valves (32) without the glue passing through the valves (32)". Furthermore, glue circulation within the apparatus can be performed by the "interaction" of the "glue supply system" and the "glue discharge system (114)". There is no description within the written description specifying how glue can be discharge by "valves (32)" without the glue passing through the "valves (32)". Within the specification reference number refers to a "glue drain" which connects the first glue reservoir with the second reservoir and allows for glue to by-pass the third glue reservoir. According to the written description this "glue drain" has no connection with the valves of reference number 32. Furthermore, there is no description within the written description of a "glue circulation and/or glue exchange" process within the apparatus. It is apparent from the written description that the transport of glue within the apparatus is unilateral and is not designed in anyway to be circulatory.

To fulfill the written description requirement, a patent specification must describe an invention and do so in sufficient detail that one skilled in the art can clearly conclude that "the inventor invented the claimed invention." *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966(1997); *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989) ("[T]he description must clearly allow persons of ordinary skill in the art

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to recognize that [the inventor] invented what is claimed.”) Thus, an applicant complies with the written description requirement “by describing the invention, with all its claimed limitations, not that which makes it obvious,” and by using “such descriptive means as words, structures, figures, diagrams, formulas, etc., that set forth the claimed invention.” *Lockwood*, 107 F.3d at 1572, 41 USPQ2d at 1966.

112 2nd

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 1, 3-4, 9-14, 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Claims 1, 12-13 are rejected under 35 U.S.C. 112, second paragraph, as containing unnecessary references to figures. Where possible, claims are to be complete in themselves. Incorporation by reference to a specific figure or table “is permitted only in exceptional circumstances where there is no practical way to define the invention in words and where it is more concise to incorporate by reference than duplicating a drawing or table into the claim. Incorporation by reference is a necessity doctrine, not for applicant’s convenience.” *Ex parte Fressola*, 27 USPQ2d 1608, 1609 (Bd. Pat. App. & Inter. 1993) (citations omitted). Reference characters corresponding to elements recited in the detailed description and the drawings may be used in conjunction with the recitation of the same element or group of elements in the claims. See MPEP § 608.01(m).

b. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01.

The omitted structural cooperative relationships are: the relationship between the first glue reservoir or glue input with the other features recited in the claim and the relationship between the glue lines and the other features recited in the claim. In claim 1 there is no description of where the glue lines are transporting glue from and there is no description of what the gluing locations are defined as.

c. Claims 12-13, 16 recites the limitation "glue supply system" in the claim. There is insufficient antecedent basis for this limitation in the claim.

d. Claims 1, 13, 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. The use of "and/or" fails to point out which features or uses the claimed invention comprise of or can be used for.

e. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of

the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 1 recites the broad recitation “at least one first glue reservoir (101) or at least one glue input (111a, b) from which glue is supplied”, and the claim also recites “at least one second glue reservoir (102)” which is the narrower statement of the range/limitation because it assumes that the apparatus contains “at one first glue reservoir”. The present invention fails to point out how the apparatus can have “at least one second reservoir” if the glue is supplied "at least one glue input" and there is no "at least one first glue reservoir". Claims 3, 9-11 14, also considered indefinite, since they are dependent on claim 1 and fail to clarify the metes and bounds of the patent protection desired.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claim 1 is rejected under 35 U.S.C. 102(b) as being taught by Sugimura et al (U.S. Patent # 5,876,502).

Sugimura et al teaches an apparatus for forming glue profiles that comprises:

a first reservoir (14) from which glue is supplied, (Column 6 Lines 65-66, Figure 1)
pipes (16, 20) which transport glue through out the apparatus, (Columns 6 Line 67, Figure 1)

a pair of glue valves (glue guns 8a, 8b) that have outlets (glue applying head 21) at the tip end of the valves and the outlets have a number of nozzles corresponding to a particular glue profile, (Column 8 Lines 51-57, Figure 1),

a second reservoir (19) which is connected to at least two valves (8, 15) (Column 7 Lines 1-3, Figure 1), and

a pressure reservoir (17, 29) which can pressurize the second reservoir (19) (Column 7 Lines 9-16, Figure 1). It is noted that “glue” in association with the apparatus features, such as reservoir or valve, is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the limitation found in preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. Thus, the said “glue” is not given any patentable weight as nothing within the claims as stated would limit the claimed apparatus to solely being applicable for forming glue profiles on bottom sheets or folded bottoms of tube portions. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

All the critical elements required by the claims are well taught by cited reference and thus the claims are properly included in this rejection.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

16. Claims 3-6 rejected under 35 U.S.C. 103(a) as being unpatentable over Sugimura et al as applied to claim 1 above, in view of Weiss (U.S. Patent # 4,655,029).

Sugimura et al teaches all of the features of claim 1 (see 102 rejection) in addition to the pressure reservoir being disposed between the first and second reservoir but does not teach that the pressure reservoir comprises a third reservoir which is at a higher pressure than the second reservoir and that the second and third reservoir are connected to one another with a pressure regulator which comprises of a valve.

Weiss teaches a pressure reservoir that comprises a pressure container (13) which is at a higher pressure than the pressurized tank (2) it is connected to and a pressure regulator comprising a valve (9) and a regulator (10) that is connected between pressure container (13) and pressurized tank (2) (Column 3 Lines 6-31, Figure 1).

Because both Sugimura et al and Weiss teach an apparatus which can hold liquid in reservoirs and deliver them through nozzles it would have been obvious to one of ordinary skill in the art to substitute the pressure reservoir of Sugimura et al with the pressure reservoir of Weiss and still have a pressure reservoir that could pressurize the second reservoir. The pressure

reservoir as taught by Weiss can still pressurize the second reservoir of Sugimura et al and still be disposed the first and second reservoir of Sugimura et al.

17. Claims 7 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sugimura et al in view of Weiss as applied to claims 1, 3-4 and, in further in view of Okajima et al (U.S. Patent # 5,660,468).

Sugimura et al in view of Weiss teaches the features of the apparatus as specified in claims 1, 3-4 (see 102 rejection and 103 rejection) but does not teach use of a pump to transfer glue from the first reservoir to another reservoir and the placement of a glue agitator within the first glue reservoir as specified in claims 7 and 10, respectively. Okajima et al teaches the use of a glue agitator in a main reservoir (Column 5 Lines 17-35). Furthermore, Okajima et al teaches the use of the agitator to manufacture glue using well known glue manufacturing methods of combining starch and water as well as a pump used to transfer glue out of the first reservoir to another storage reservoir (Column 6 Lines 24-47).

It would have been obvious to one of ordinary skill in the art that it would be advantageous to manufacture glue at the head of the apparatus in order to eliminate the costs and materials associated with manufacturing glue on- or off-site and then having to transport the glue to the first reservoir of the apparatus. Furthermore, it would be obvious that the first reservoir would need a pump for transferring glue out of the first reservoir when the reservoir having the glue transferred into it was at equal or higher pressure than the first reservoir.

Conclusion

No claims were allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Wieczorek whose telephone number is (571)270-5341. The examiner can normally be reached on Monday through Friday; 7:30 AM to 5:00 PM (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vickie Kim can be reached on (571)272-0579. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Vickie Kim/
Supervisory Patent Examiner, Art Unit 4172